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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/737,225	12/16/2003	N.R. Gandhi	5334-CIP-CON	6331

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EXAMINER	
WEIER, ANTHONY J	

ART UNIT	PAPER NUMBER
1761	

DATE MAILED: 12/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/737,225	GANDHI ET AL.	
	Examiner	Art Unit	
	Anthony Weier	1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 September 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11* is/are pending in the application.

4a) Of the above claim(s) *8-11* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I in the reply filed on 9/21/04 is acknowledged.

Claim Rejections - 35 USC § 112

2. Claims 2 and 3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 2, "said dry ground particulate" lacks antecedent basis.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Hsieh et al.

Hsieh et al discloses preparing a soybean composition comprising adding water to ground whole soybean of an average of, for example, about 10 microns (which would include soybean having a particle size above as well as below 10 microns) thus forming a slurry (which inherently possesses a liquid consistency), wherein said soybean

composition is then homogenized to pressures as high as 8000 psi and heated at between 70-90 C (e.g. col. 2, lines 40-43; col. 3, lines 37-50).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hsieh et al taken together with JP 0207655.

The claims differ with respect to the presence of an acid salt or buffer system of said salt. However, it is known to add acid to soybean drinks as taught, for example, by JP 02076550 (see Abstract). Although it is not discussed as being in a salt form, it is not seen where same would provide for a patentable distinction regarding the product of same. In any event, it would have been obvious to one having ordinary skill in the art at the time of the invention to have added acid (acetic or citric) for the reasons of JP 02076550 (aids in removing soybean odor) and to have employed the salt form of said acid as an art recognized alternative.

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hsieh et al (as applied in paragraph 3 above) taken together with Drachenberg et al.

Hsieh et al is silent regarding the use of at least one of a stabilizer, suspension agent, emulsifier, or combination of same. However, Drachenberg et al teaches the preparation of a similar soybean composition wherein emulsifier is added to hold

existing soybean oil in suspension in the final product (see col. 5, lines 47-50). It would have been obvious to one having ordinary skill in the art at the time of the invention to have included same to provide a more uniform product.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hsieh et al (as applied in paragraph 3 above) taken together with any one of Crank et al, Jolivet et al, and Wagner et al.

Although Hsieh et al further discloses that homogenization may be repeated, there is no suggestion that same be done at a lower pressure on a subsequent treatment as called for in claim 6. Nevertheless, two-stage homogenization using a first pressure greater than a second pressure is notoriously well known in liquid processing (including that of soybean-related materials). For example, Crank et al teaches treatment of a soybean concentrate at a high pressure followed by a lower pressure (Col. 12, lines 34-58). Jolivet et al (e.g. col. 2, lines 19-25; Example 1) and Wagner et al (e.g. Example 1) each teach the two-stage homogenization of a soybean composition using a first pressure greater than the second. Absent a showing of unexpected results, it would have been obvious to one having ordinary skill in the art at the time of the invention to have employed such two-stage, two-pressure, homogenization in the process of Hsieh et al as an art recognized alternative for treatment of soybean compositions.

7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hsieh et al (as applied in paragraph 3 above) taken together with Koga et al.

The claims further call for a product which is spray dried into a powder. However, it is notoriously well known to spray processed dry soy milk into powders for future preparation as a beverage as taught, for example, by Koga et al (see Abstract). Absent a showing of unexpected results, it would have been further obvious to have done same as a conventional, art recognized alternative product form that may be easily reconstituted to prepare a beverage.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-3 and 5 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, and 5 of U.S. Patent No. 6322846.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims call for employing whole ground soybean particles of less than about 10 microns whereas said claims of U.S. Patent No. 6322846 are silent concerning same. However, absent a showing of unexpected results, it would

have been obvious to one having ordinary skill in the art at the time of the invention to have arrived at such particle size as a matter of preference depending on the particular texture desired in the final product. The instant claims further differ in that they call for the treatment of liquid at a pressure of 2000 psi and the claims of U.S. Patent No. 6322846 require a pressure greater than about 6000 psi. Nevertheless, said claims overlap, and, absent a showing of unexpected results, it would have been further obvious to have modified the pressure range of the claims of U.S. Patent No. 6322846 to a lower limit as a matter of preference depending on the particular degree of pressure treatment desired.

10. Claim 4 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, and 5 of U.S. Patent No. 6322846 taken together with Drachenberg et al.

Although the conflicting claims are not identical, they are further not patentably distinct from each other because the claims of U.S. Patent No. 6322846 are silent regarding the addition of at least one of the components set forth in instant claim 4. However, Drachenberg et al teaches the preparation of a similar soybean composition wherein emulsifier is added to hold existing soybean oil in suspension in the final product (see col. 5, lines 47-50). It would have been obvious to one having ordinary skill in the art at the time of the invention to have included same to provide a more uniform product.

11. Claim 6 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, and 5 of U.S. Patent No. 6322846 taken together with any one of Crank et al, Jolivet et al, and Wagner et al.

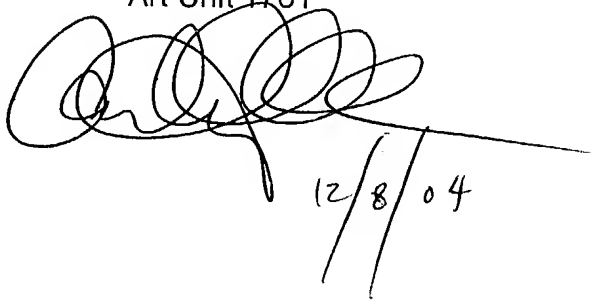
Although the conflicting claims are not identical, they are further not patentably distinct from each other because the claims of U.S. Patent No. 6322846 are silent regarding the use of a two pressure treatment in which the second pressure is lower than the first. However, two-stage homogenization using a first pressure great than a second pressure is notoriously well known in liquid processing (including that of soybean-related materials). For example, Crank et al teaches treatment of a soybean concentrate at a high pressure followed by a lower pressure (Col. 12, lines 34-58). Jolivet et al (e.g. col. 2, lines 19-25; Example 1) and Wagner et al (e.g. Example 1) each teach the two-stage homogenization of a milk base (including soybean) using a first pressure greater than the second. Absent a showing of unexpected results, it would have been obvious to one having ordinary skill in the art at the time of the invention to have employed such two-stage, two-pressure, homogenization as an art recognized alternative for treatment of soybean compositions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Weier whose telephone number is 571-272-1409. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-0987.

Anthony Weier
Primary Examiner
Art Unit 1761



Anthony Weier
December 8, 2004